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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/528,321
Filing Date: September 26, 2005
Appellant(s): GUFFANTI, STEPHEN

STEPHEN GUFFANTI
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 08/13/2010 appealing from the Office action mailed 10/28/2009.

(1) Real Party in Interest

The Examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims pending: 1-20

Claims rejected: 1-20.

(4) Status of Amendments After Final

The Examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The Examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Examiner has no comment on the Appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the Examiner except for the grounds of rejection (if any) listed under subheading

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“WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the sub heading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The Examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

Guffanti, Stephen, and Maureen Guffanti. *Rocket Phonics: help your child reach for the stars*. Children ‘s U.com, August 15, 2001.

US 4,196,529

Esbensen

04-1980

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

- The following is a **Final Office Action** in response to communications received on 07/17/2009. Claims 1, 7, 14-15 and 18 have been amended. Thus, claims 1- 20 are pending in this application.

Drawings

- The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Claim 14 recites “a reading assist card having a window”. However, the drawings fail to illustrate this claimed feature as recited in the claim. FIG 10 of the current drawings appears to depict a "peeker" to represent the recited “reading assist card”; however, FIG 10 does not sufficiently illustrate the structure of the above claimed feature (e.g. it does not illustrate a card having a window). Therefore, the “reading assist

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card” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

Regarding claims 1-14, these claims are directed to a nonfunctional descriptive subject matter since there is no functional relationship between the printed matter and the substrate. It has been held that a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Regarding claims 15-20, in order for a claimed process to be considered statutory it must be direct to more than an abstract idea. Evidence that the process is not an abstract idea can be found if the process is: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing.

The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "at least 90%" in line 1 of claim 3 renders the

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claim indefinite since it is not clear what limitation(s) is encompassed in the scope of the claim.

Claim Rejections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-13 and 15-20 are rejected under 35 U.S.C 102(a) as being unpatentable over "Rocket Phonics", (hereinafter Rocket Phonics).

Rocket phonics discloses the following claimed limitations:

Regarding claim 1, a system for teaching phonics, comprising a training apparatus that includes a visual representation of a plurality of words using ordinary spelling, and adjacently positioned clarifying symbols, wherein each clarifying symbol consists entirely of underlined or non- underlined letters of a standard alphabet (Page 43),

Regarding claim 2, the clarifying symbols assist in sounding out at least part of each of the plurality of words (Page 44, lines 4-11),

Regarding claim 3, at least 90% of letters in the standard alphabet compose the clarifying symbols (Page 45),

Regarding claim 4, the clarifying symbols consist entirely of 24 letters of the English alphabet (Pages 120-124 and 143-147),

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Regarding claims 5 and 6, the standard letters and the clarifying symbols together comprise an initial teaching alphabet consisting of less than 44 phonograms; the standard letters and the clarifying symbols together comprise an initial teaching alphabet consisting of 36 phonograms (Page 12),

Regarding claims 7 and 8, at least one of the symbols has a prompt that shows that a portion of one of the plurality of words form a blended sound; the prompt comprises a line under the plurality of the letters (page 27 and page 43),

Regarding claim 9, a coloration of a selected one of the standard letters to show that such letter is silent in the word (page 43, lines 8-9),

Regarding claims 10 and 11, a modification of a selected one of the standard letters to show that the selected letter sounds according to the adjacent phonetic symbol; the modification comprises colorizing the selected letter (Pages 43-44),

Regarding claims 12 and 13, differences in case of the letters are not used to represent differences in sound; the adjacently positioned clarifying symbols are placed below corresponding ones of the standard letters of at least some of the words (Page 45),

Regarding claim 15, a method of teaching phonetic reading, comprising: presenting to a student an alphabet of phonetic symbols consisting of underlined and non-underlined letters selected from the group consisting of a, b, c, d, e, f, g, h, i, j, k, l, m, n, o, p, q, r, s, t, u, v, w, x, y, z; (Page 43), revising at least part of the word to include at least one of the phonetic symbols (Pages 44-45),

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Regarding claims 16 and 17, phonetic symbols consisting of single letters correspond to short vowel sounds; phonetic symbols consisting of more than one letter represent long vowel sounds (Pages 49-50),

Regarding claim 18, displaying a line of words with ordinary spelling to the student and revising at least part of the line of words to include at least one of the phonetic symbols (Page 49),

Regarding claims 19 and 20, a sentence of at least five words with ordinary spelling, and placing phonetic symbols of the alphabet below selected ones of the words as aids in pronunciation of the selected words; displaying at least one of the words without a corresponding one of the phonetic symbols (Page 50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rocket phonics in view of Esbensen 4,196,529.

Regarding claim 14, Rocket phonics discloses the claimed limitations as discussed above.

Rocket phonics does not explicitly disclose, a reading assist card having a window.

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However, Esbensen discloses a teaching device and method that teaches, a reading assist card having a window (co1.4, lines 7-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rocket Phonics in view of Esbensen by incorporating a window card that has opening to Rocket Phonics's invention in order to help the student to learn the words in such a way that when the teacher reads a given word, the student attempts to get the letters that make the word through the openings of the window card, thereby learning the correct spellings.

(10) Response to Arguments

Appellant's arguments filed on 08/13/2010 have been fully considered'; but they are not persuasive. In the remarks, Appellant argues:

(1) *Here, Claim 15 recites "presenting to the student a word with ordinary spelling" and "revising at least part of the word to include at least one of the phonetic symbols." The Specification teaches that this word is presented on one of several types of training material: training books, teach/parent guides, and games, which are all physical objects. (See Specification, P9) This training material is then transformed by the addition of phonetic symbols to the word that is written on the training material. The training material necessarily needs to undergo a physical transformation for the words written on the material to be revised by the student.*

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- In response to argument (1), the Examiner respectfully disagrees. The claims still do not stratify the statutory requirement under 35 U.S.C. 101. In order for a claimed process to be considered statutory it must be direct to more than an abstract idea.

Evidence that the process is not an abstract idea can be found if the process is: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing.

The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process.

However, the above claims (for example see independent claim 15) still do not satisfy any of the above statutory requirement; and therefore, the current calms are not patentable under 35 U.S.C. 101.

Appellant further argued, "The Specification teaches that this word is presented on one of several types of training material: training books, teach/parent guides, and games".

However, the above argument appears to be directed to the specification rather than the claims. Note that claims are given their broadest reasonable interpretations in light of the disclosure without importing any limitations from the specification. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Limitations appearing in the specification but **not recited in the claim** are **not read**

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into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

That means, even if some training materials such as books, teach/parent guides and games are discussed in the specification, the Examiner is not required to narrowly interpret any of the features recited in the claims by importing such narrow interpretation(s) from the specification. Note that if Appellant wants a given limitation(s) in a claim(s) to have a particular interpretation, then it is Appellant's responsibility to incorporate that particular interpretation into the claim(s).

(2) *The Supreme Court held that "[t]he machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible 'process'" Bilski et al. v. Kappos 561 U.S. __ (2010) . . .*

In Diamond v. Diehr, 450 U. S. 175, 185 (1981), the Supreme Court held that the execution of a physical process, controlled by a computer program, was patentable. Likewise, in this case, a physical process, controlled by a student, is performed; namely, the transformation of one word to another word by adding phonetic symbols to a training material. Again, a physical transformation is performed by the claims.

- In response to argument (2), the 35 U.S.C. 101 rejection presented in the Final Office Action is not solely based on machine-or-transformation test; rather, the machine-or-transformation test is utilized as one of the investigative tools for determining patentability. As it is already indicated in the Final Office Action (and also in this current response), the 35 U.S.C. 101 rejection states, **"Whoever invents or discovers any**

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new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title”.

That means, a patentable subject matter should correspond to one of the four statutory categories: process, machine, manufacture or composition of matter.

However, for the reasons discussed above, the current claims do not correspond to any of these four statutory categories; and therefore, do not satisfy the statutory requirement under 35 U.S.C. 101.

Secondly, Appellant's comparison of the **execution of a physical process controlled by a computer program** with the **current invention** is extensively unrelated. A physical process that is controlled by a computer may undergo some changes depending on the type of the program. For instance, a program that is designed to cut or shape physical objects (such as wood or steel) will shape or cut the physical objects when the program is executed on a machine (i.e. when the program is integrated with the machine).

However, in the instant case, there is absolutely no such transformation. First of all, as currently claimed, the alphabets and symbols are not presented as physical objects; rather, the alphabets and the symbols are presented as elements written or painted on a surface where there are no functional relationships between the letters or symbols and the substrate (i.e. these are nonfunctional printed or descriptive matters).

Secondly, the alphabets along with their symbols presented or displayed to the student will remain as they are (i.e. they do not change) no matter what the student

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does. This is because, as already indicated above, these are merely elements painted on a surface; and therefore, in the current case, there is no such machine or process that transforms a physical object.

Therefore, the Examiner concludes that Appellant's argument is not persuasive.

(3) *The actual publication date of "Rocket Phonics" was on August 8, 2002. An explanation of why the publication date for "Rocket Phonics" was given in several affidavits filed with the Office in accordance with 37 C.F.R. § 1.131. A corrected Supplementary Registration was filed with the United States Copyright Office on January 25, 2010 pursuant to 17 U.S.C. §408(d), and once the United States Copyright Office processes this registration, the Appellant will submit the new Supplementary Registration to this Board as evidence.*

- In response to argument (3), the Examiner respectfully disagrees. First of all, according to the information obtained from the online record of the US Copyright at the time of the Final Office Action was mailed (and also currently), "Rocket Phonics" is recorded as being published on August 15, 2001 (see the attached copy).

Secondly, even if Appellant indicated, in the declaration filed under 37 C.F.R. 1.131, the publication date of the above book as being on September 2, 2002 (see declaration that was filed on July 17th 2009), there was no explanation (not even mentioned) in the declaration as to why the indicated date in the declaration (September 2, 2002) contradicts with the publication date indicated in the US Copyright (which is August 15th, 2001).

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Thirdly, the publication dates presented by Appellant do not appear to be consistent. For instance, according to Appellant's declarations filed on July 17th, 2009 and December 22, 2009, the publication date of the book is indicated as September 2, 2002 (see paragraph 1 of each declaration); whereas, according to the argument presented in this *Appeal Brief* (see second paragraph under section B), Appellant has indicated that the actual publication date of the book as August 8, 2002. The publication dates provided by Appellant do not appear to be consistent.

Therefore, the Examiner concludes that since the above book is published more than a year before the filing date of the current application, it does qualify as a prior art under 35 U.S.C.102(b).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this examiner's answer.

For the reasons discussed above, it is believed that the rejections should be sustained.

Respectfully submitted,

/Bruk A Gebremichael/

Examiner, Art Unit 3715

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